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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/062,255	04/17/1998	PAUL T. MARAVETZ	B0932/7088RF	2738

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EXAMINER
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VANAMAN, FRANK BENNETT

ART UNIT	PAPER NUMBER
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3618

DATE MAILED: 09/10/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
**09/062,255**

Applicant(s)  
**Maravetz et al.**

Examiner  
**Vanaman**

Art Unit  
**3618**



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Jun 12, 2002
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-28, 30-43, and 45-86 is/are pending in the application.
- 4a) Of the above, claim(s) 78 and 82-86 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 24, 33-43, 45-50, 73, 80, and 81 is/are allowed.
- 6) ☒ Claim(s) 1-23, 25-28, 30-32, 51-72, 74-77, and 79 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 6) ☐ Other:

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### Claim Objections

1. The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not). In this case, applicant has presented claims 79, 80 and 82-87, but not 81.

Misnumbered claims 82-87 been renumbered 81-86.

### Election/Restriction

2. Claims 82-86 (previously referred to as 83-87) are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made without traverse in Paper No. 12.

Please note the original election of species requirement:

“This application contains claims directed to the following patentably distinct species of the claimed invention: Species I, as shown in figures 1-2, Species II in figures 24-31, Species III in figures 32-37. No claims appear to be directed to species shown in figures 3-23 or 38-46.”

No claims were originally directed to the species shown in figures 15-23. Applicant's election, **without traverse**, of Species II in paper 12 did not question the propriety of the particular species definition as being incorrectly directed to figures 24-31.

3. Newly submitted claims 82-86 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: these claims are directed to disclosed species to which no claims have been previously directed.

4. Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the

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merits. Accordingly, claims 82-86 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

#### **Miscellaneous papers**

5. Applicant's submission of a substitute specification, further copies of the drawings, and non-marked claims, unaccompanied by a transmission letter or explanation of relevance is noted. These papers have been placed in the file, but have not been entered in the application.

#### **Claim Rejections - 35 USC § 112**

6. Claims 1-23, 25-28, 30-32, 51-72, 74-77 and 79 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 1, 51, 54, 61, and 74 are confusing in that the recitations appear contradictory: in claim 1, lines 4 and 16; claim 51, line 12; claim 54, lines 1 and 10; claim 61, lines 1 and 10; and claim 74, line 4, reference is made to a non-safety releasable binding, however in claim 1, lines 18 and 19; claim 51, lines 14-16; claim 54, lines 11-12; claim 61, lines 11-12; and claim 74, lines 9-12 the recitations are directed to an automatic release associated with the removal of a boot from a binding. Such automatic release appears contradictory with the recitation that the binding is non-safety releasable, absent further recitation reconciling the non-safety releasability and the automatic release associated with a boot stepping out of the binding.

#### **Claim Rejections - 35 USC § 103**

7. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

8. Claims 1-5, 7-12, 15, 17-19, 25, 27, 30-32, 51-64, 66-72, 74-77 and 79 are rejected under 35 U.S.C. 103(a) as being unpatentable over Romano in view of Bobrowicz (US 5,815,952).

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Romano teaches a step-in engagement system for connecting a shoe (8) to a pedal (1) comprising a cleat (5) located on a lower shoe surface and attached thereto with screws (6) and having a base with a pair of chamfered sides (12, 10a) presenting an overall wider profile towards the base than away therefrom (note figs. 2, 3), which is provided with a pair of shelves (e.g., 9) which retain a pair of movable retaining loops (48, 48a, fig. 7, 8) which are spring biased (more clearly shown at 19) which have a width and height greater than a fixed stop element (15, also tabs 40) and can bend about the fixed stop element (one sided version in fig. 4), the fixed stop provided to define the lower end of motion for the cleat. The cleat is further provided with a pair of lips (10, 11) at the shoe-facing base surface, which retain the loops in the attached position (fig. 8). The cleat is adapted to be connected to the retaining loops by a downward motion which spreads the retaining loops apart and allows them to close and retain the cleat through the interaction of the loops and the shelves (9) of the cleat, whereby a vertically upward motion is prevented, but through a pivoting motion (e.g., about a vertical axis associated with the cleat- fig. 5) the cleat can be released from the engaging loops.

The reference of Romano fails to explicitly teach the binding device as usable between a snowboard boot and binding. Bobrowicz teaches a system for connecting a shoe (2, 3, 4) to a snowboard through a binding pair (30, 34; or 50; or 60-63, etc), wherein the boot is taught to also use connection schemes of the sort used to connect bicycle shoes to pedals (cols. 7-8). It would have been obvious to one of ordinary skill in the art at the time of the invention to use the attachment system of Romano to connect a snowboard boot, such as taught by Bobrowicz, to a snowboard as suggested by Bobrowicz, for the purpose of allowing the easy connection and disconnection advantages taught by Romano to a snowboard user.

The reference of Romano as modified by Bobrowicz fails to teach that the mating engagement loops and cleat may be used such that the loops and surfaces 10a and 12 are located laterally with respect to one another, rather than longitudinally. In view of the motions of operation remaining the same (i.e., a vertical downward motion to attach and a pivoting motion to

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release) regardless of the orientation of the cleat and engaging members, it would have been obvious to one of ordinary skill in the art at the time of the invention to orient the cleat and cleat engagement mechanism such that the cleat presents lateral and medial chamfered surfaces, for the purpose of decreasing the longitudinal overall length of the front binding element of Romano as modified by Bobrowicz, in order to use a smaller quantity of material.

The reference of Romano as modified by Bobrowicz fails to explicitly teach the free end of the cleat as being narrower than the loop-to-loop distance and the base end as being wider. It would have been obvious to one of ordinary skill in the art at the time of the invention to provide the free end of such a width that the free end may easily engage and spread apart the loops (as required for operation of the vertical engagement) and further it would have been obvious to one of ordinary skill in the art at the time of the invention to provide the base end of such a width that the loops are maintained under a degree of tension for the purpose of insuring that the loops exert a reaction force (e.g., towards 10, 11) to prevent an undesired disengagement of the cleat from the loops.

#### **Allowable Subject Matter**

9. Claims 6, 13, 14, 16, 20-23, 26, 28 and 65 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2<sup>nd</sup> paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

10. Claims 24, 33-43, 45-50, 73, 80, 81 are allowed.

11. Applicant is reminded that claims 78 and 82-86 are withdrawn from consideration as being drawn to a non-elected species.

#### **Response to Arguments**

12. Applicant's arguments have been carefully considered. As regards the claim rejections under 35 USC 112, second paragraph, while applicant's comments are noted, the claim recitation

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is still deemed confusing. Specifically, the recitations of (a) the binding being non-safety releasable, i.e., *not* automatically moving to a release position under the effect of forces applied by the boot against the binding and (b) the automatic operation of the binding to the release position in response to a rider stepping out of the binding, are deemed contradictory, in the absence of any distinguishing characteristics between these two conditions. More specifically, applicant has defined the non-safety releasing nature of the binding as the binding not releasing in response to a lifting force generated at the toe, whereas the binding *does* release in response to a user stepping out of the binding, which involves the generation of a lifting force along the boot, including the toe.

As regards the reference to Romano and applicant's comments directed to safety release of the connection, the definition applicant now appears to be applying as "non-safety releasable" (page 7 of the response filed 2/11/02), is that a rotation of the boot with respect to the binding results in a release. This appears to contradict the previous definition applicant has specifically set forth (see paper 24, filed 5/16/01, pages 5, 6, where applicant suggests the definition and further points out the passages in the specification which support the definition), wherein a non-safety releasing binding is one wherein "no amount of lifting force generated on the toe end of the boot will result in disengagement". In this case, it appears that the reference of Romano meets applicant's *previous* non-safety releasing definition, in that upward force at the toe or any other portion of the boot will not result in the disconnection of the boot from the binding.

As regards the applicability of a binding as taught by Romano in a snowboard environment, applicant's comments that the reference to Bobrowicz teaches that certain types of bindings used on cycle pedals *can* be used with his boot (a snowboard boot) appears to support the rejection, in that Bobrowicz promotes the use of bindings such as those taught for use on connecting cycling shoes to cycle pedals for connecting a snowboard boot to a binding. Also please note the reference to Tanaka (US 5,845,421) cited previously.

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Applicant's comments that certain more specific claim limitations are not being argued at this time, although such a lack of arguments should not be considered an acquiescence that the Office action is correct are noted. It remains to be noted however, that these further issues have not been addressed by applicant in that applicant has not pointed out any further supposed errors in the rejections as set forth.

### Conclusion

13. The Group and/or Art Unit location of your application in the PTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Group Art Unit 3618.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to F. Vanaman whose telephone number is (703) 308-0424. Any inquiry of a general nature or relating to the status of this application should be directed to the group receptionist whose telephone number is (703) 308-1113.

Any response to this action should be mailed to:

Assistant Commissioner for Patents

Washington, DC 20231

or faxed to :

(703) 305-3597 or 305-7687 (for formal communications intended for entry;  
informal or draft communications may be faxed to the same number but should be  
clearly labeled "UNOFFICIAL" or "DRAFT")

The Office has also established electronic fax servers for Technology Center 3600 as follows:

703-872-9326 (Official communications)

703-872-9327 (Official After Final communications)

703-872-9325 (Customer Service)

**F. VANAMAN**  
**Primary Examiner**  
**Art Unit 3618**

F. Vanaman  
September 5, 2002

Handwritten signature of F. Vanaman, dated 9/5/02.